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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,287	11/13/2003	Naoki Kusunoki	Q78-442	5668
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EXAMINER				
ALUNKAL, THOMAS D				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/706,287	Applicant(s) KUSUNOKI ET AL.
Examiner THOMAS D. ALUNKAL	Art Unit 2627

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.

13. ☐ Other: _____.

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627

/Thomas D Alunkal/
Examiner, Art Unit 2627

Continuation of NOTE 11: Regarding the applicant's arguments beginning on page 2 of Remarks, the applicant argues that Nakano (US 6,391,439) does not disclose all of the claimed limitations of independent claim 1. Specifically, the applicant argues that Nakano fails to disclose that "indication information is written by irradiating light in a form of an image onto the indication layer" as recited in claim 1. To support this assertion, the applicant argues that only the recording medium 8 of Nakano is irradiated with light and that the label base layer and rewritable indication layer are not irradiated with light. However, Column 2, lines 51-56 disclose that label base layer may be formed of various kinds of synthetic paper (which corresponds to the electronic paper recited in claim 2). The specific coloring of the synthetic paper is formed by the irradiation of light. Thus, the rewritable indication layer which is provided on one side of the label base layer is also provided with the irradiation of light. Therefore, Nakano does disclose that "indication information is written by irradiating light in a form of an image onto the indication layer".

Regarding the applicant's arguments beginning on page 3 of Remarks, the applicant argues that the combined teachings of Anderson et al. (US 6,778,205) in view of Araki et al. (US PgPub 2003/0103762) do not disclose all of the claimed limitations of claim 3. Specifically, the applicant continues to argue that the cited references are not combinable. As noted in the previous Office Action on page 2, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As noted on page 6 of said Office Action, "...both Anderson and Araki disclose recording mediums with indication layers for indicating information related to the disc. The difference between Anderson and Araki is the type of indication layer disclosed." The types of indication layers disclosed in Anderson and Araki are art recognized equivalent indication layers which provide visually perceived information pertaining a disc. Thus, a substitution of indicating layers "...is well within the scope of knowledge that is known to one of ordinary skill in the art because the substitution results in a predictable result", as recited on page 6 of said Office Action. Therefore, the Examiner believes that the teachings of Anderson and Araki are combinable.

Regarding the applicant's arguments beginning on page 5 of Remarks, the applicant argues that Anderson et al. (US 7,145,586) does not disclose "a detection section detecting a difference between storage data which is stored at the storage layer of the recording medium, and new data which is to subsequently stored; and a generating section which...generates indication information which corresponds to the difference...and the writing section writes, at the indication layer, the indication information which corresponds to the difference." As noted on page 3 of the previous Office Action, the marking on the disc of Anderson et al. is indicative of the amount of space either used or remaining on the disc. When the amount of space used or remaining on the disc changes, the existing marking on the data side of the label side of the optical disc is determined. After the existing marking is determined, a difference between the amount of space used on the disc is determined and a new marking is provided to reflect the detected difference between old storage space and new storage space. Thus, Anderson et al. does disclose "a detection section detecting a difference between storage data which is stored at the storage layer of the recording medium, and new data which is to subsequently stored; and a generating section which...generates indication information which corresponds to the difference...and the writing section writes, at the indication layer, the indication information which corresponds to the difference."